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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,560	04/26/2001	David Mallis	09432/168002	9436

22511 7590 05/14/2003

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

Office Action Summary

Application No.

09/843,560

Applicant(s)

MALLIS, DAVID

Examiner

Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The applicant's amendment filed 3/3/03 (Paper No. 5) has been fully considered and made of record.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Newly submitted Claim 20 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the feature of the wear indicator comprising "a circumferential extension" is a feature that was not originally presented and is distinct from the originally presented or claimed features of the wear indicator.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claim 20 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. Claims 4-9 and 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 4, the recitation of “an external shoulder” (lines 1-2) as this refers to the pin member is unclear of this referring to the previous recitation of “a shoulder of the pin member” (lines 7 of Claim 1). How many shoulders does the pin member have? The same problems above also occur in each of Claims 8, 13 and 17.

In Claim 5, the recitation of “an external shoulder” (lines 1-2) as this refers to the box member, is unclear if this is referring to the previous recitation of “a shoulder of the box member” (line 7 of Claim 1). How many shoulders does the box member have? The same problems above also in each of Claims 8, 14 and 17.

In Claim 6, the recitation of “an internal shoulder” (lines 1-2) as this refers to the pin member is unclear of this referring to the previous recitation of “a shoulder of the pin member” (lines 7 of Claim 1). How many shoulders does the pin member have? The same problems above also occur in Claim 15.

In Claim 7, the recitation of “an internal shoulder” (lines 1-2) as this refers to the box member, is unclear if this is referring to the previous recitation of “a shoulder of the box member” (line 7 of Claim 1). How many shoulders does the box member have? The same problems above also in Claim 16.

Claim Rejections - 35 USC § 103

5. Claims 1-19, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Boice 4,317,585 in view of Blose 4,192,553

Boice discloses a threaded pipe connection and a method of indicating connection wear comprising: a pin member 14 having external threads 18; a box member 16 having internal

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threads 22; a wear indicator or means for indicating connection wear (either one of marks 26 or 28 and see col. 2, lines 16-20) disposed on a shoulder 20; rotationally engaging the pin member and the box member (see col. 2, lines 5+).

Regarding Claims 2-9 and 11-18, as best understood, the pin member 14 has a shoulder 20, which can be read as either an "internal shoulder" or an "external shoulder"; and the box member has a shoulder (unthreaded counterbore 24), which can be read as an "internal shoulder" or an "external shoulder". When the pin member 14 and the box member 16 are connected together, the wear indicator (either 26 or 28) can be said to be disposed on both the shoulders of the pin member and the box member.

Boice discloses substantially all of the limitations of the claimed invention except that the external threads of the pin member increase in width in one direction and the internal threads of the box member increase in width in another direction.

Blose shows pin and box members (in Figs. 5 and 6), each having threads with widths that increase in directions opposite to each other. One such advantage of having this type of pipe connection prevents axial and radial separation of the pin and box members (see col. 1, lines 13-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the threads on the pin and box members of Boice by having widths increase in directions opposite to each other to advantageously prevent axial and radial separation of the pin and box members.

Response to Arguments

6. Applicant's arguments filed 3/3/03 have been fully considered but have not been deemed to be found as persuasive.

In regards to the merits of Boice, the applicant urges that Boice does not teach any "shoulder" that the wear indicator is disposed on.

The examiner most respectfully disagrees. The claimed "shoulder" as now recited in each of Claims 1 and 10, was read as the region labeled by element 20. For further clarification, the examiner has attached a copy of Boice's Figures 1 and 2 in which the highlighted region is illustrated as the claimed "shoulder". Moreover, the highlighted regions also satisfy the limitations of either an "internal shoulder" or an "external shoulder", as best understood, as recited in the dependent claims. Therefore, the examiner maintains the rejection of Boice and Blose.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

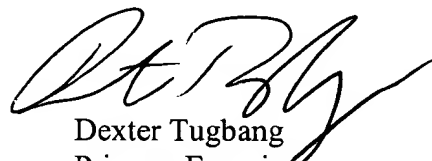
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Dexter Tugbang
Primary Examiner
Art Unit 3729

adt
May 12, 2003